

FILED  
UNITED STATES DISTRICT COURT CLERKS OFFICE  
DISTRICT OF MASSACHUSETTS

2004 APR -6 A 11:00

BACOU-DALLOZ USA SAFETY, INC., and  
HOWARD LEIGHT INDUSTRIES, LLC

Plaintiffs,

v.

CABOT SAFETY INTERMEDIATE  
CORPORATION and AEARO COMPANY,

Defendants.

U.S. DISTRICT COURT  
DISTRICT OF MASS.

Case No.

**04-40049-NMG**

---

**COMPLAINT FOR DECLARATORY JUDGMENT**

---

Plaintiffs Bacou-Dalloz USA Safety, Inc. ("Bacou") and Howard Leight Industries, LLC ("HLI"), by their undersigned attorneys, for their Complaint against defendants Aearo Company ("Aearo") and Cabot Safety Intermediate Corporation ("CSF"), allege as follows:

**Parties**

1. Plaintiff Bacou is a Delaware corporation with a place of business at 910 Douglas Pike, Smithfield, Rhode Island. Bacou's primary business is the manufacture and sale of safety products. Prior to January 1, 2004, one of Bacou's operating divisions conducted the hearing protection business under the name Howard Leight Industries. Since January 1, 2004, HLI, a subsidiary of Bacou, and a limited liability company of Delaware with a place of business at 7828 Waterville Road, San Diego, California, has conducted such hearing protection business. Prior to February 27, 1998, this business was held by Howard Leight & Associates, Inc. ("HLA"). Bacou, HLI and HLA are hereinafter collectively referred to as "Leight."

2. Upon information and belief, Defendant Aearo is a Delaware corporation with a place of business at 35 Optical Drive, Southbridge, MA.

RECEIPT # 4040292  
AMOUNT \$ 150.00  
SUMMONS ISSUED ✓  
LOCAL RULE 4.1 ✓  
WAIVER FORM ✓  
MCF ISSUED ✓  
BY DPTY CLERK AND DEPUTY  
DATE 4-6-04

3. Upon information and belief, CSI is a wholly-owned subsidiary of Aearo, and shares Aearo's place of business at 35 Optical Drive, Southbridge MA.

### **Subject Matter Jurisdiction**

4. Insofar as this is an action for a declaratory judgment, jurisdiction arises under Sections 2201 and 2202 of the Judicial Code, 28 U.S.C. §§ 2201, 2202. Jurisdiction over the underlying case of actual controversy arises under Sections 37 and 39(a) of the Trademark Act of 1946, as amended, 15 U.S.C. §§ 1119, 1121(a) and Sections 1331, 1338(a), 1338(b) and 1367 of the Judicial Code, 28 U.S.C. §§ 1331, 1338(a), 1338(b) and 1367.

### **Personal Jurisdiction**

5. Defendants by virtue of having a place of business in Southbridge MA., within the District of this Court, are amenable to personal jurisdiction of this Court.

### **Venue**

6. Venue is proper in this District because pursuant to Sections 1391(b) and (c) of the Judicial Code, 28 U.S.C. §§ 6. Venue is proper in this District because pursuant to Sections 1391, defendants are deemed to reside within the district of the Court.

### **General Allegations: Case or Controversy**

7. Aearo and Leight are, and have been for many years, competitors in the United States in the manufacture and sale of disposable ear plugs for use in industry. Aearo has sold

and sells most or all of such earplugs under the trademark E·A·R. Leight has sold and sells most or all of such earplugs under the trademark HOWARD LEIGHT.

8. Upon information and belief, since approximately 1973, most of the earplugs Aeero has sold have been colored yellow, molded in a cylindrical shape, and dispensed in individual packets plainly marked with the brand name E·A·R.

9. In 1997, Aeero and CSI commenced an action in this Court (Civil No. 97-40216-NMG) to restrain Leight from manufacturing and selling partially yellow-colored disposable earplugs in individual packets plainly labeled HOWARD LEIGHT.

10. That action ended when this Court entered summary judgment against Aeero and CSI on the merits, dismissing all claims.

11. On March 23, 2004, Aeero and CSI recommenced legal action to restrain Leight from manufacturing and selling yellow-colored earplugs. A true copy of the Complaint in AEARO COMPANY AND CABOT SAFETY INTERMEDIATE CORPORATION v. BACOU-DALLOZ USA SAFETY, INC. HOWARD LEIGHT INDUSTRIES DIVISION, United States District Court for the Southern District of Indiana, Indianapolis Division Case No. 1:04-CV-0547 RLY – WTL is annexed hereto as Exhibit A.

#### **FIRST CLAIM FOR RELIEF**

12. The majority of Leight's disposable earplugs and, upon information and belief, of Aeero's E·A·R plugs are sold for use in industries in which OSHA mandates that such earplugs be worn and that employers monitor employee compliance.

13. Bright colors, such as yellow, assist employers in monitoring their employees' compliance with OSHA hearing protection requirements.

14. Upon information and belief, early advertising for E·A·R plugs correctly and accurately stated:

The bright yellow color of E-A-R plugs has always been a big advantage as they are highly visible and aid compliance checks. E-A-R has experimented with many colors but found yellow to be the most easily seen at a distance.

15. The color yellow, therefore, is functional for earplugs, the wearing of which is subject to OSHA compliance monitoring, so no valid trademark rights may exist in that color for such products.

## **SECOND CLAIM FOR RELIEF**

16. Ownership in the alleged trademark in the color yellow for earplugs is reflected by United States trademark registration 1,435,400. Aearo and CSI claim that CSI is the owner of the registration and trademark for yellow-colored earplugs, and that Aearo is the exclusive “licensee” of the rights to use the trademark.

17. Upon information and belief, Aearo is the entity that manufactures and sells the E·A·R yellow-colored earplugs.

18. By law, Section 6 of the Trademark Act, 15 U.S.C. § 1055, the benefits of Aearo’s use “inure” to the benefit of CSI only if the registered mark E·A·R is used by a “related company” of CSI.

19. By law, Section 45 of the Trademark Act, 15 U.S.C. § 1127, Aearo is a “related company” of CSI only if Aearo’s “use of the mark is controlled by the owner of the mark [CSI] with respect to the nature and quality of the goods or services on or in connection with which the mark is used.”

20. Upon information and belief, for more than three years, CSI has been a wholly-owned subsidiary of Aearo, and consequently has no power or ability to realistically control Aearo with respect to the nature and quality of the yellow-colored earplugs which Aearo makes and sells.

21. Since the benefits of Aearo's use of the yellow-colored earplug trademark have not inured to the benefit of CSI for more than three years, by statute, Section 45 of the Trademark Act, 15 U.S.C. § 1127, whatever rights there may otherwise have been in the trademark are *prima facie* abandoned.

### **THIRD CLAIM FOR RELIEF**

22. Leight makes yellow-colored earplugs in the United States which it ships to jurisdictions outside the United States only.

23. Leight is unaware of any yellow-colored earplugs it may have manufactured for sale abroad reentering the United States. If there has been any such trans-shipment back to the United States, it has been without Leight's knowledge, consent or intent, and, moreover, the quantities, upon information and belief, are *de minimus* and have no significant effect on United States commerce.

24. There is, therefore no subject matter jurisdiction over such sales abroad.

### **FOURTH CLAIM FOR RELIEF**

25. To the extent, if any, to which Aearo and CSI assert relief against Leight's sale of partially yellow-colored earplugs in commerce, they are precluded by principles of res judicata (a.k.a. "claim preclusion and/or collateral estoppel", a.k.a. "issue preclusion") from doing so.

**WHEREFORE**, Defendant Leight prays:

A. that this Court enter a judgment declaring: (1) that the color yellow is functional and cannot be a trademark for earplugs; (2) that to the extent the color yellow may ever have been a valid trademark for earplugs, it has been abandoned; (3) that Leight's manufacture and shipment abroad of yellow-colored earplugs for retail sale outside the United States violates no right of Aearo or CSI; and (4) that the continued manufacture and sale of the earplugs which are the subject of *Cabot Safety Intermediate Corp. and Aearo Company v. Howard S. Leight and Associates, Inc.*, Civil Action No. 97-40216-NMG violates no right of Aearo or CSI; and

B. that this Court enter an order directing the Director of Trademarks in the United States Patent and Trademark Office to cancel Registration No. 1,435,400 pursuant to Section 37 of the Trademark Act, 15 U.S.C. § 1120; and

C. that this Court enter an order preliminarily enjoining Aearo, CSI and any entity in privity with either of them, from further prosecuting *Aearo Company and Cabot Safety Intermediate Corporation v. Bacou-Dalloz USA Safety, Inc. Howard Leight Industries Division*, United States District Court for the Southern District of Indiana, Indianapolis Division Case No. 1:04-CV-0547 RLY – WTL; and

D. that this Court award Leight its costs and its attorney's fees pursuant to Section 35(a) of the Trademark Act, 15 U.S.C. § 1117(a); and

E. for such other and further relief as to this Court may seem fair, just and equitable.

Respectfully submitted,

Dated: April 5, 2004

A handwritten signature in cursive script, reading "Charles Hieken", is written over a horizontal line.

Charles Hieken (BBO 233640)  
Gregory A. Madera (BBO 313020)  
225 Franklin Street  
Boston, MA 02110-2804  
Tel.: (617) 542-5070  
Attorneys for Plaintiffs,  
BACOU-DALLOZ USA SAFETY, INC. and  
HOWARD LEIGHT INDUSTRIES, LLC

## CIVIL COVER SHEET

04-40049-NMG

JS-44 (Rev. 3/99)

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

## I. (a) PLAINTIFFS

BACOU-DALLOZ USA SAFETY, INC., and  
HOWARD LEIGHT INDUSTRIES, LLC

## DEFENDANTS

CABOT SAFETY INTERMEDIATE  
CORPORATION AND AEARO COMPANY

(b) County of Residence of First Listed Plaintiff Providence  
(EXCEPT IN U.S. PLAINTIFF CASES)

County of Residence of First Listed \_\_\_\_\_  
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE  
LAND INVOLVED.

## (c) Attorney's (Firm Name, Address, and Telephone Number)

Charles Hieken, Esq.  
Gregory A. Madera, Esq.  
Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Tel. (617) 542-5070

## Attorneys (If Known)

Michael J. Rye, Esq.  
Andrew C. Ryan, Esq.  
Cantor Colburn LLP  
55 Griffin Road South  
Bloomfield, CT 06002  
Tel. (860) 286-2929

## II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff  
☐ 2 U.S. Government Defendant  
☒ 3 Federal Question (U.S. Government Not a Party)  
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

## III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- Citizen of This State ☐ 1 ☐ 1 Incorporated or Principal Place of Business in This State ☐ 4 ☐ 4  
Citizen of Another State ☐ 2 ☐ 2 Incorporated and Principal Place of Business in Another State ☐ 5 ☐ 5  
Citizen or Subject of a Foreign Country ☐ 3 ☐ 3 Foreign Nation ☐ 6 ☐ 6

## IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS		FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of <input type="checkbox"/> Judgment/Car Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability	<b>PERSONAL INJURY</b> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	<b>PERSONAL INJURY</b> <input type="checkbox"/> 362 Personal Injury <input type="checkbox"/> 365 Personal Injury <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <b>PERSONAL PROPERTY</b> <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <b>PROPERTY RIGHTS</b> <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce/ICC Rates/etc. <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes <input type="checkbox"/> 890 Other Statutory Actions
<b>REAL PROPERTY</b> <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	<b>CIVIL RIGHTS</b> <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 440 Other Civil Rights	<b>PRISONER PETITIONS</b> <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	<b>LABOR</b> <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<b>SOCIAL SECURITY</b> <input type="checkbox"/> 861 HIA (1395m) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIW C/DIW W (405(g)) <input type="checkbox"/> 864 SSD Title XVI <input type="checkbox"/> 865 RSI (405(g)) <b>FEDERAL TAX SUITS</b> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS Third Party 26 USC 7609	

## V. ORIGIN

(PLACE AN "X" IN ONE BOX ONLY)

- ☒ 1 Original Proceeding  
☐ 2 Removed from State Court  
☐ 3 Remanded from Appellate Court  
☐ 4 Reinstated or Reopened  
☐ 5 Transferred from another district (specify) \_\_\_\_\_  
☐ 6 Multidistrict Litigation  
☐ 7 Appeal to District Judge from Magistrate Judgment

## VI. CAUSE OF ACTION

(Cite the U.S. Civil Statute under which you are filing and write brief statement of cause.  
Do not cite jurisdictional statutes unless diversity.)

15 U.S.C. Sec. 1331, 1338(a), 1338(b), 1367, Cancellation of trademark registration and noninfringement of trademark

## VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

## DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☐ Yes ☒ No

## VIII. RECEIVED BY IF ANY

INSTRUCTIONS

JUDGE

Charles Hieken

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE



UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

04-40049-NMG

1. Title of case (name of first party on each side only) Bacou-Dalloz USA Safety, Inc. v. Cabot Safety Intermediate Corporation
2. Category in which the case belongs based upon the numbered nature of suit code listed on the civil cover sheet. (See local rule 40.1(a)(1)).
- ☐ I. 160, 410, 470, R.23, REGARDLESS OF NATURE OF SUIT.
- ☒ II. 195, 368, 400, 440, 441-444, 540, 550, 555, 625, 710, 720, 730, 740, 790, 791, 820\*, 830\*, 840\*, 850, 890, 892-894, 895, 950. \*Also complete AO 120 or AO 121 for patent, trademark or copyright cases
- ☐ III. 110, 120, 130, 140, 151, 190, 210, 230, 240, 245, 290, 310, 315, 320, 330, 340, 345, 350, 355, 360, 362, 365, 370, 371, 380, 385, 450, 891.
- ☐ IV. 220, 422, 423, 430, 460, 510, 530, 610, 620, 630, 640, 650, 660, 690, 810, 861-865, 870, 871, 875, 900.
- ☐ V. 150, 152, 153.
3. Title and number, if any, of related cases. (See local rule 40.1(g)). If more than one prior related case has been filed in this district please indicate the title and number of the first filed case in this court.
- 
4. Has a prior action between the same parties and based on the same claim ever been filed in this court?
- YES ☒ NO ☐
5. Does the complaint in this case question the constitutionality of an act of congress affecting the public interest? (See 28 USC §2403)
- YES ☐ NO ☒
- If so, is the U.S.A. or an officer, agent or employee of the U.S. a party?
- YES ☐ NO ☐
6. Is this case required to be heard and determined by a district court of three judges pursuant to title 28 USC §2284?
- YES ☐ NO ☒
7. Do all of the parties in this action, excluding governmental agencies of the united states and the Commonwealth of Massachusetts ("governmental agencies"), residing in Massachusetts reside in the same division? - (See Local Rule 40.1(d)).
- YES ☐ NO ☒
- A. If yes, in which division do all of the non-governmental parties reside?
- Eastern Division ☐ Central Division ☐ Western Division ☐
- B. If no, in which division do the majority of the plaintiffs or the only parties, excluding governmental agencies, residing in Massachusetts reside?
- Eastern Division ☐ Central Division ☒ Western Division ☐
8. If filing a Notice of Removal - are there any motions pending in the state court requiring the attention of this Court? (If yes, submit a separate sheet identifying the motions)
- YES ☐ NO ☐
- (PLEASE TYPE OR PRINT)
- ATTORNEY'S NAME Charles Hieken and Gregory A. Madera
- ADDRESS Fish & Richardson P.C., 225 Franklin Street, Boston, MA 02110-2804
- TELEPHONE NO. (617) 542-5070